Application No. 10/616,195 ·
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REMARKS

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I.   SPECIFICATION

A.   The objection to the specification should be withdrawn because the URL stated in the specification is not an incorporation by reference, but merely an example URL that is permitted by MPEP § 608.01.

Applicant respectfully traverses the Examiner's objection to the specification regarding the example "embedded hyperlink" found on page 2, line 19. The following is a quotation of the relevant paragraph in MPEP § 608.01 concerning hyperlinks:

> The attempt to incorporate subject matter into the patent application by reference to a hyperlink and/or other forms of browser-executable code is considered to be an improper incorporation by reference. See >37 CFR 1.57(d) and< MPEP § 608.01(p), paragraph I regarding incorporation by reference. Where the hyperlinks and/or other forms of browser-executable codes themselves rather than the contents of the site to which the hyperlinks are directed are part of applicant's invention and it is necessary to have them included in the patent application in order to comply with the requirements of 35 U.S.C. 112, first paragraph, and applicant does not intend to have these hyperlinks be active links, examiners should not object to these hyperlinks. The Office will disable these hyperlinks when preparing the text to be loaded onto the USPTO web database. (emphasis added)

The specification on page 2 with the example URL states:

> A browser is able to access a web site on the Internet through the use of a URL. The URL may include a Hypertext Transfer Protocol (HTTP) request combined with the web site's internet address, also known as the web site's domain name. An example of a URL with a HTTP request and domain name is:
> http://www.companyname.com
>
> In this example, the "http" identifies the URL as a HTTP request and the "www.companyname.com" is the domain name.

The URL in question is not attempting "to incorporate subject matter into the patent application by reference to a hyperlink" nor is it intended to be an active link. The content of any web site at the example URL, assuming there is even an active web site there, is not incorporated into nor part of the disclosure for this invention. The example URL is merely being used to explain "part of Applicant's invention" (as permitted by MPEP § 608.01) and thus Applicant respectfully requests the withdrawal of this objection.

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II.   CLAIM REJECTION – 35 USC § 101

    A.   **Independent claims 1 and 6 (and thus their dependent claims 2-5 and 7-10) have been amended to make it clear they are directed towards statutory subject matter.**

The Office Action on page 3 states "Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter." Applicant has amended the preamble of independent claims 1 and 6 to clarify that the reseller program utilizes a computer network and are thus directed towards statutory subject matter. With the amendments to claims 1 and 6 (and thus their dependent claims 2-5 and 7-10), Applicant respectfully requests the withdrawal of this rejection.

    B.   **The Statutory Double Patenting rejection should be withdrawn because the claims do not have identical subject matter.**

The OA on page 5 states:

> Claim 6 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 6 of copending Application No. 10/616,005. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.
> As to claim 6, Michael teaches the same invention as in claim 6 of copending Application No. 10/616,005.

The relevant section in the MPEP related to statutory double patenting is as follows:

MPEP 804 II A.   Statutory Double Patenting - 35 U.S.C. 101

In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. "Same invention" means identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a "halogen" substituent is not identical to or substantively the same as a claim reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine." On the other hand, claims may be differently worded and still define the same invention. Thus, a claim reciting a widget having a length of "36 inches" defines the same invention as a claim reciting the same widget having a length of "3 feet."

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Original claim 6 (please note that an amendment to claim 6's preamble made in this Amendment is not shown below so as not to confuse the current issue) from the current application (App. No. 10/616,195) is:

6.   A reseller program for allowing a plurality of Customers to register one or more domain names via a Registrar, comprising:

A)   a registrar web site adapted for receiving <u>selected domain names from a plurality of Customers</u> and for registering <u>the selected</u> domain names with an appropriate Registry; and

B)   an administration web site adapted for allowing Resellers to enter the reseller program and allowing each Reseller to customize the registrar web site for their Customers.

Original claim 6 from App. No. 10/616,005 is:

6.   A reseller program for allowing a plurality of Customers to register one or more domain names via a Registrar, comprising:

A)   a registrar web site adapted for receiving <u>information from a reseller web site</u> and registering domain names with an appropriate Registry; and

B)   an administration web site adapted for allowing Resellers to enter the reseller program and allowing each Reseller to customize the registrar web site for their own Customers.

Applicant respectfully submits that the same invention is not being claimed twice because receiving "<u>selected domain names from a plurality of Customers</u>" (from claim 6 in Application No. 10/616,195) has a different claim scope than receiving "<u>information from a reseller web site</u>" (from claim 6 in Application No. 10/616,005). Specifically, not only is the type of data received different, ("selected domain names" vs. "information"), but the source of the data is also different ("plurality of Customers" vs. "a reseller web site"). Applicant respectfully requests the withdrawal of this objection.

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III. CLAIM REJECTIONS – 35 USC § 103

Claims 1-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bayles (U.S. Patent No. 7,039,697) in view of Vaidyanathan et al. (U.S. Publication No. 2002/0138291). Applicant respectfully traverses this rejection.

A. The obviousness objection should be withdrawn for claims 1 and 11 because not every element is shown.

1. Bayles does not teach a Customer being guided to a registrar web site from actions by a Reseller.

MPEP 2143.03 All Claim Limitations Must Be Taught or Suggested

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Office Action on page 6 states that Bayles teaches:

C)   means for allowing a plurality of Customers to register one or more domain names via the registrar web site, wherein at least one of the plurality of Customers was guided to the registrar web site from actions by one of the plurality of Resellers (column 6, lines 26-28)

The relevant section of Bayles cited in the OA (column 6, lines 26-28), however, teaches only that:

Primary customers of a business employing the present invention would be domain name registrars and resellers (such as in a thick registry system).

Applicant respectfully submits that nowhere in this cite is it taught or inherent that a Customer may be guided to a registrar web site from actions by a Reseller. Because at least the limitation of a Customer being guided to a registrar web site from actions by a Reseller is not taught by Bayles, Applicant respectfully requests the allowance of independent claims 1 and 11 and their dependent claims 2-5 and 12-15.

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2.   **Vaidyanathan does not teach means for compensating each Reseller that guided a Customer to the registrar web site that registered a domain name.**

The Office Action on page 6 states:

> However, Vaid teaches digital file marketplace. Vaid teaches means for compensating each Reseller that guided a Customer to the registrar web site that registered a domain name (figure 2; page 2, [0019]).

Vaidyanathan at paragraph [0019] states:

> [0019] According to the present invention, the marketplace 10 allows the content owners 14 to set both the retail price charged to the consumer 16, as well as a commission paid to the reseller 15. The marketplace 10 generates revenue by charging the content owners 14 transaction fees. Thus, when the consumer 16 downloads a file 12, the consumer 16 is charged the retail price set by the owner. The transaction fee charged by the marketplace and any reseller commission is then subtracted from the retail price collected from the consumer 16. The marketplace 10 then transfers any remaining money to the content owner 14 as payment.

Applicant respectfully submits that Vaidyanathan does not teach means for compensating each Reseller that guided a Customer to a registrar web site that registered a domain name as stated in the Office Action on page 6. As a preliminary matter, Vaidyanathan does not even disclose a "registrar web site" or registering a "domain name." In addition, there is no mention of a Reseller that "guided" a Customer anywhere, let alone a registrar web site.

B.   **The obviousness objection should be withdrawn for claims 1 and 11 (and thus dependent claims 2-5 and 12-15) because Vaidyanathan teaches away from the claimed process because it teaches compensating a Reseller for downloading files from the Reseller's own web site.**

Instead of guiding Customers to a registrar web site, Vaidyanathan teaches downloading files from the Resellers' own web sites. This can be seen in Vaidyanathan's abstract (second to last sentence) where it states "[i]f the second user [Customer] downloads the particular file from the third party website [Reseller's website], then the first user [Reseller] is paid the reseller commission set for the file." In addition, the last sentence in paragraph [0017] states "[r]esellers are third parties who also offer the files 12 to the public on a third party website." Thus, Resellers are paid for downloading files to Customers from their own web sites, not for guiding Customers to a registrar web site.

Therefore, not only does Vaidyanathan fail to teach guiding customers to a registrar web site, it teaches away from claims 1 and 11 by teaching the process of downloading files to its

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Customers from the Resellers' <u>own</u> third party web site. Simply put, Resellers downloading files to Customers from their <u>own</u> web sites does not teach the claim limitation of Resellers <u>guiding</u> Customers to a registrar web site. Thus, not every element in claims 1 and 11 (and their dependent claims 2-5 and 12-15) is disclosed, therefore claims 1-5 and 11-15 should be allowed.

<p style="margin-left: 2em;">C.   The obviousness objection should be withdrawn for claims 6 and 16 because not every element is shown.</p>

<p style="margin-left: 4em;">1.   Bayles and Vaidyanathan do not teach an <u>administration web site</u> adapted for allowing <u>Resellers to enter the reseller program</u>.</p>

The Office Action on page 6 states:

> As to claims 1, 6, 11 and 16, Bayles teaches a reseller program embodied in a machine readable medium and a process for allowing a plurality of Customers to register one or more domain names via a Registrar, comprising:

Claim 6 includes the limitation:

> B)   an <u>administration web site</u> adapted for allowing <u>Resellers to enter the reseller program</u> and allowing each Reseller to customize the registrar web site for their Customers.

Claim 16 includes the limitation:

> B)   creating an <u>administration web site</u> adapted for allowing <u>Resellers to enter the turnkey reseller program</u> and allowing each Reseller to customize the registrar web site for their Customers;

Neither Bayles nor Vaidyanathan disclose an administration web site that allows <u>Resellers to enter a reseller program</u>. In fact, neither Bayles nor Vaidyanathan even mention a reseller program, let alone an administration web site that allows <u>Resellers to enter a reseller program</u>. Since at least this claim limitation is not taught, Applicant respectfully requests the allowance of independent claims 6 and 16 along with their dependent claims 7-10 and 17-20.

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2.   **Bayles and Vaidyanathan do not teach an <u>administration web site</u> adapted for allowing each <u>Reseller to customize the registrar web site for their Customers</u>.**

The Office Action on page 6 states:

> As to claims 1, 6, 11 and 16, Bayles teaches a reseller program embodied in a machine readable medium and a process for allowing a plurality of Customers to register one or more domain names via a Registrar, comprising:

Claim 6 includes the limitation:

> B)   an <u>administration web site</u> adapted for allowing Resellers to enter the reseller program and allowing each <u>Reseller to customize the registrar web site for their Customers</u>.

Claim 16 includes the limitation:

> B)   creating <u>an administration web site</u> adapted for allowing Resellers to enter the turnkey reseller program and allowing each <u>Reseller to customize the registrar web site for their Customers</u>;

Neither Bayles nor Vaidyanathan disclose an administration web site that allows <u>Resellers to customize the registrar web site for their Customers</u>. In fact, neither Bayles nor Vaidyanathan even mention a reseller program, let alone an administration web site that allows <u>Resellers to customize the registrar web site for their Customers</u>. Since at least this claim limitation is not taught, Applicant respectfully requests the allowance of independent claims 6 and 16 along with their dependent claims 7-10 and 17-20.

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IV.   CONCLUSION

Applicant respectfully submits that not all of the claim limitations are taught by Bayles and Vaidyanathan for claims 1-20 as explained above. Applicant thus requests the allowance of all pending claims, i.e. claims 1-20 as soon as possible. Any questions or suggestions regarding this Amendment should be directed to the undersigned attorney for Applicant at the telephone number or email address listed below.

Respectfully submitted,

The Go Daddy Group, Inc.

Date: 5/3/2007

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